

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.:	6116729
Grant Date:	September 12, 2000
Application No.:	09376842
Confirmation No.:	7025
Inventor:	Huang, Tsung-Hui
Title:	HAND MAGNIFYING GLASS
Owner/Assignee:	Carson Optical, Inc.
Atty. Ref:	CARS2001/TJM

**PETITION FOR RECONSIDERATION
TO ACCEPT UNAVOIDABLY DELAYED
PAYMENT OF MAINTENANCE FEE**

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Assignee hereby petitions for reconsideration of the Decision dated September 17, 2012 (referred to below as the “Decision”), which denies the Petition under 37 C.F.R. §1.378 filed on May 14, 2012 (referred to below as the “Petition”) to accept the unavoidably delayed payment of the 7.5 years maintenance fee for U.S. Patent No. 6,116,729 (referred to below as the “the ‘729 Patent”). Assignee files herewith the U.S. government petition fee for this petition for reconsideration. The authorization to charge all maintenance fees to the deposit account of the undersigned appears in the Petition. A deposit account authorization appears in the penultimate paragraph of this petition for reconsideration.

Assignee files herewith the following: (1) DECLARATION OF J. ERNEST KENNEY; (2) DECLARATION OF GEORGE CHEN; (3) DECLARATION OF MS. CHEN; (4) DECLARATION OF THOMAS J. MOORE; and (5) a copy of Decision as requested..

“In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.” Burandt v. Dudas, 528 F.3d 1329, 1333 (Fed. Cir. 2008), quoting Ray v. Lehman, 55 F.3d 606, 609 (Fed. Cir. 1995). The party responsible for payment is “the legal title owner” in the records of the U.S. Patent and Trademark Office (referred to below as the “USPTO”). Burandt, 528 F.3d at 1334. The Court rejected consideration of any party other than the legal title owner: “Moreover, even if Burandt could have been considered the equitable owner of the patent, that status would not override the fact that IRI was the owner of record with the legal responsibility of paying the maintenance fees.” Id. at 1334.

In the present case, GEM Optical Co., Ltd. (“GEM Optical”) was the owner of record of the ‘729 Patent on September 12, 2008, which was the last day to pay the 7.5 years maintenance fee with surcharge.

GEM Optical instructed Talents International Patent & Trademark Office of Taiwan (“Talents”) to pay the 7.5 years maintenance fee. Talents had previously paid the 3.5 years maintenance fee at the instruction of GEM Optical. Thus, GEM Optical exercised the due care of a reasonably prudent person in selecting Talents.

Talents requested a cost estimate from Bacon & Thomas, PLLC of Alexandria, Virginia (“Bacon & Thomas”), for payment of the 7.5 years maintenance fee in an email on June 25, 2008. See paragraphs 3 and 4 of the Declaration of Ms. Chen. Bacon & Thomas has provided maintenance fee payment services since the U.S. patent law was amended to require maintenance fees. See paragraph 4 of the Declaration of Thomas J. Moore. Thus, Talents exercised the due care of a reasonable person in selecting Bacon & Thomas.

Bacon & Thomas prepared invoice no. 61038 for the payment of the 7.5 years maintenance fee, but made an error in the last two digits of the patent number. The invoice listed U.S. Patent No. 6,116,758 (referred to below as “the ‘758 Patent”). This invoice was sent to Ms. Chen by an email dated June 28, 2008. The correct patent number appears in the subject line of the email, but the erroneous patent number appears in the attached invoice. Ms. Chen of Talents observed her correct reference number for the ‘729 Patent, but did not notice the error in the patent number. See paragraphs 6 and 7 of the Declaration of the Ms. Chen, and Exhibits T-2 and T-3 thereto. A copy of this email was also sent to George Chen of Bacon & Thomas, but he did not notice the error in the attached invoice. See paragraph 11 of the Declaration of George Chen.

Ms. Chen of Talents sent a “Notice of Remittance” letter to Bacon & Thomas by facsimile letter of August 21, 2008. See paragraph 8 of the Declaration of Ms. Chen and Exhibit T-4 thereto. This letter included the erroneous patent number but the correct Talents’ reference number because Ms. Chen copied the erroneous patent number from invoice no. 61038. See paragraph 9 of the Declaration of Ms. Chen.

Bacon & Thomas paid the 7.5 years maintenance fee for the erroneous patent number. The documentation was prepared by Ms. Harris and reviewed by Attorney J. Ernest Kenney. See paragraphs 6 and 7 of the Declaration of J. Ernest Kenney. This payment was transmitted to the USPTO by letter of August 21, 2008. See Exhibit K-1 to his Declaration. Before signing this transmittal letter, Mr. Kenney compared it to the receipt card and the check shown in Exhibit K-2, and to Notice of Remittance from Talents shown as Exhibit K-3. The erroneous ‘758 Patent number appears in all of these documents, but the correct ‘729 Patent number does not. The maintenance fee deadline was the same for the ‘758 Patent and the ‘729 Patent, so the timing of instruction shortly before the deadline did not raise any question. Subsequently, Bacon & Thomas received the Maintenance Fee Statement from the USPTO acknowledging this payment of the 7.5 years maintenance fee for the ‘758 Patent. See paragraph 10 of the Declaration of Thomas J. Moore. At that time, the maintenance fee address for the ‘729 Patent was J.C. Patents Inc. of California, and

they have no record of receiving from the USPTO a notice of expiration of the '729 Patent. See the Declaration of J.C. Patents Inc. that was filed with the original petition on May 14, 2012.

The Decision states that “A failure in communication does not constitute unavoidable delay” citing Kim v. Quigg, 718 F.Supp. 1280, 1282 (E.D.Va. 1989) See Decision at page 5, fourth paragraph. The court in Kim stated the relevant facts: in September, 1984, Dr. Tam understood that attorney Rowland would appeal a final rejection, but attorney Rowland understood that the assignee intended to “abandon the patent application.” Id. However, there was no written communication to Dr. Kim that an appeal was filed, and it was not until over 16 months later on February 19, 1986, that Dr. Kim telephoned attorney Rowland and became aware that the application was abandoned. Id. The present case does not involve a “failure” in communication as occurred in the Kim case. In the present case, there was an express communication from Bacon & Thomas to Talents that the 7.5 years maintenance fee was paid, and an express communication from Talents to GEM Optical that the 7.5 years maintenance fee was paid.

In the present case, the legal owner, GEM Optical, instructed Talents to pay the maintenance fee, and Talents instructed Bacon & Thomas. Bacon & Thomas acknowledged those instructions, but included an erroneous patent number in its invoice sent to Talents. Talents then incorporated this erroneous information into their transmission of payment to Bacon & Thomas. Bacon & Thomas reported the payment of the maintenance fee to Talents, and Talents reported the payment to GEM Optical. The present delay results from an error in the last two digits of the patent number, not a failure in communication.

The Decision further states that “The record fails to adequately evidence that the patent owner and its representatives exercised the due care and diligence observed by prudent and careful persons in relation to their most important business, which is necessary to establish unavoidable delay.” There is no citation of case law, a statute or a rule to support the “most important business” standard applied by the Decision. The standard set forth by the U.S. Court of Appeals for the Federal

Circuit is “whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.” Burandt, 528 F.3d at 1333.

The Decision also states that “Petitioner did not provide statements from persons with firsthand knowledge explaining how this error went unnoticed and why their systems did not alert them to the nonpayment of the second maintenance fee in the ‘729 Patent.” Decision at page 6, second paragraph. The statements from persons with firsthand knowledge are filed herewith. Ms. Chen of Talents instructed payment with respect to the correct patent number, but did not notice that the email from Ms. Harris of Bacon & Thomas dated June 28, 2008, had a discrepancy. See paragraph 7 of the Declaration of Ms. Chen. This discrepancy lists the correct patent number in the subject line, but the erroneous patent number in the attachment which is the invoice. George Chen of Bacon & Thomas also reviewed this email, and did not notice the discrepancy. See paragraph 11 of the Declaration of George Chen. The subsequent payment of the maintenance fee for the erroneous patent number was reviewed by attorney J. Ernest Kenney. See paragraphs 7-8 of the Declaration of J. Ernest Kenney. He matched the erroneous patent number on maintenance fee transmission letter to the erroneous patent number in Talents’ “Notice of Remittance” letter. After the payment of the maintenance fee, Bacon & Thomas received a confirmation of the payment in a Maintenance Fee Statement from the USPTO. See paragraph 10 of the Declaration of Thomas J. Moore. The erroneous patent number in this Maintenance Fee Statement was matched to the erroneous patent number on maintenance fee transmission to the USPTO.

There is no declaration by Ms. Harris because she could not be located. She is no longer an employee of Bacon & Thomas. She is not at the address or telephone number which she used while she was an employee of Bacon & Thomas. See paragraph 19 of the Declaration of Thomas J. Moore. An investigation by Pinkerton investigative services found an address where Ms. Harris was believed to reside. See paragraphs 20-21 of the Declaration of Thomas J. Moore. However, when Mr. Moore traveled there on November 13, 2012, an occupant stated that he had no knowledge of Ms. Harris. See paragraph 22 of the Declaration of Thomas J. Moore.

A change in procedure should ensure that the error of the present case will not be repeated. Talents will now confirm the payment of each maintenance fee by checking the online U.S. Patent Bibliographic Data from the web site of the USPTO. See paragraph 11 of the Declaration of Ms. Chen.

The Decision states that “A late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application.” Decision at paragraph 4, second paragraph. This standard fails to reflect a difference in the patent law that allows for intervening rights in the event that the USPTO accepts an unavoidably delayed payment of a maintenance fee as stated in 35 U.S.C. 41(c)(2), but does not allow for intervening rights in the event that the USPTO revives an application that was abandoned due to unavoidable delay. This difference was recognized by the U.S. Court of Appeals to distinguish certain case law in the Burandt case: “Moreover, both cases concerned abandoned patent applications pursuant to 37 C.F.R. § 1.137 rather than reinstatement of expired patents due to nonpayment of maintenance fees pursuant to 37 C.F.R. § 1.378.” 528 F.3d at 1334.

The Director is authorized to charge to deposit account no. 02-0200 any fees that are authorized by the undersigned by telephone, and any fees that are required for the processing of the petitions, and any fees to prevent the lapse of the ‘729 Patent. The Director is authorized to credit any overpayments to deposit account no. 02-0200

A decision granting this petition for reconsideration is earnestly solicited.

Date: November 16, 2012
Customer No, 23,364
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Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Thomas J. Moore", written over a horizontal line.

Thomas J. Moore
Attorney for Applicant
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